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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,038

11/13/2003

Satoshi Ishikawa

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EXAMINER

FELTON, MICHAEL J

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

06/13/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,038	<b>Applicant(s)</b> ISHIKAWA ET AL.	
	<b>Examiner</b> MICHAEL J. FELTON	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-4,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 2-4, 6, and 7 have been considered but are moot in view of the new ground(s) of rejection.
2. The applicant argues that claim 7 is not a product by process claim. The examiner disagrees. The applicant is claiming a process of decreasing the amount of calcium carbonate on the top and bottom surface of the wrapper paper. Although the claim does not disclose the specifics of the process used to decrease the calcium carbonate in the top and bottom layers, the limitation is a process step and therefore has been treated as a product by process claim.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Yamazaki et al. do not disclose a double-sided dehydration type wire) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
4. Applicant argues that the references fail to teach or suggest an ash content in the surface layer of the wrapper paper and that it would not be inherent. However, the examiner disagrees for the reasons stated in the rejection below.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6 and 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for the claim limitation of “not higher than 30% by mass” for ash content in the surface layer on each of the top and bottom side of the wrapper paper. Although the specification and original claims indicate less than 35% ash content for these structures, there is no indication that the invention had a critical amount of not higher than 30%.

7. The specification also does not provide support for the claim limitation “wherein the percentage of ash content in a surface layer on each of the topside and a bottom side of the wrapper paper is lower than a total ash content in percentage of the wrapper paper”. In particular, paragraph 0033 of the specification describes the product of the invention with a similar ash content throughout the paper, not with a higher or lower percentage of ash content in the surface regions. In particular:

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In the wrapper paper manufactured by the twin wire type paper making machine, the difference in the content of the loading material between the inner region and the surface region of the paper layer is small and, thus, the difference in the loading material content between the entire paper layer and each layer is considerably small (paragraph 0033).

There appears to be no indication that the surface layers have a lower percentage than then any other portion of the paper as currently being claimed.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6, 7 and 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex*

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*parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 6 recites the broad recitation that the top side and bottom side have lower than a total ash content in percentage, and the claim also recites that the top side and bottom side have ash content not higher than 30% by mass, which is the narrower statement of the range/limitation.

11. With respect to claim 7, it is not clear how, what process steps or the amount that is encompassed by "is decreased". Would a normal variation of 0.00001% be included? The claim clearly seems to teach a process step, but applicant is arguing it is not. The scope of the claim is thus not clear.

### ***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 2-4 and 6-7 rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent office publication EP 0791688 to Yamazaki ("Yamazaki") in view of Smook (Handbook for Pulp & Paper Technologies, section 20.7).

14. Regarding claim 6 and 2-4, Yamazaki teaches a cigarette paper with at least 30 g/m<sup>2</sup> of calcium carbonate [paragraphs 16 and 34] and at least 3% by mass of potassium or sodium citrate burn adjusting agents [table 4; paragraph 68], but does not indicate the ash content of a top or bottom surface layer. However, the examiner believes that the ash content of the paper of Yamazaki

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would be inherent because Yamazaki teaches a paper having essentially the same composition. (see MPEP citation below).

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). MPEP section 2112.

15. In addition, although Yamazaki disclose making handsheets that are commonly used to test papers, it would have been obvious to one of ordinary skill that the paper of Yamazaki could be made using standard paper production equipment. One of the well known methods of making tissue papers (a category that includes cigarette papers), includes twin-wire formers (Smook, page 316-317 and 319, especially "Modern Tissue Formers" on page 317). Therefore, the paper of Yamazaki, produced on standard paper making machines, would inherently have the same attributes as that of the instant invention.

16. In the event any differences can be shown for the product of claim(s) 2-4 and 6, as opposed to the product taught by the reference Yamazaki, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of showing of unexpected results.

17. Regarding claim 7, the instant claim contains product by process claims. Such claims are handled as laid out in MPEP section 2113.

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"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product" itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) ...

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) ... "

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore, of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith."/n re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

18. As for claim 7, The step of "decreasing the surface layer calcium carbonate" is deemed not to impart patentable non-obviousness because no non-obvious structural characteristics are associated with the step in the specification.



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19. However, the process as disclosed in the specification of using a twin-wire paper forming machine to for the cigarette wrapper is met by Smook as applied to claim 6 above (see Smook, page 316-317, especially "Modern Tissue Formers" on page 317).

20. In the event any differences can be shown for the product of the product-by- process claim(s) 7, as opposed to the product taught by the reference Yamazaki, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of showing of unexpected results; see also *In re Thorpe*, 777 F.2d 695,698,227 USPQ 964,966 (Fed. Cir. 1985).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is (571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. F./  
Examiner, Art Unit 1791

/Philip C Tucker/  
Supervisory Patent Examiner, Art Unit 1791